

REMARKS

Claims 1-8, 13-21 and 26 are rejected under 35 U.S.C. §103(e) as being unpatentable over *Dodson* (U.S. 6,513,159). Claims 9 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Dodson*, and further in view of *Kenyon et al.* (U.S. 2002/0100035). Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Independent claims 1 and 14 include: ... the program identifying an operating system manufacturer and version and determining if the version is older than a current required version;...

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the *Dodson* patent alone, or in combination with *Kenyon et al.*, do not teach the program identifying an operating system manufacturer and version and determining if the version is older than a current required version.

Therefore, it is impossible to render the subject matter of claim as a whole obvious based on the *Dodson* patent considered alone or in combination with the *Kenyon et al.* patent, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1 and 14, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the *Dodson* and *Kenyon et al.* patents cannot be combined and applied to reject claims 1 and 14 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, Dodson and Kenyon et al do not teach, or even suggest, the desirability of the combination because neither teaches or suggests providing the program identifying an operating system manufacturer and version and determining if the version is older than a current required version.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claims 1 and 14.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1 and 14. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1 and 14, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1 and 14 and the claims dependent therefrom are submitted to be allowable.

PATENT

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In view of the above, it is respectfully submitted that claims 1-9, 13, 14-22 and 26 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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on Feb 1, 2006
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